

Remarks/Arguments:

Summary of Changes Made

By this Amendment, claim 1 has been amended, claims 6, 7, 9, 32-45 and 48-50 have been canceled and new claim 58 has been added to the application. Accordingly, claims 1, 3, 5, 10-31, 46, 47 and 51-58 are currently pending in the application.

Applicants' Responses to Issues Raised in Prior Office Action

In the prior Office Action, the Examiner rejected claims 6, 7 and 9 under 35 U.S.C. §103 on grounds that the methods claimed therein were unpatentable over unspecified portions of *Remington's Practice of Pharmacy*. By this Amendment, claims 6, 7 and 9 have been canceled, thereby rendering the prior rejection thereof moot.

New claim 58, which is substantially similar to original claim 4 (which was canceled in the Amendment filed on March 17, 2003), claims a method of treating a subject afflicted with a central or peripheral nervous system disorder such as mood disorders, Parkinson's disease and parkinsonian disorders, gastrointestinal disturbances, edema formation states and hypertension, where a reduction in the O-methylation of catecholamines may be of therapeutical benefit, comprising administering to the subject an amount of a compound according to claim 1 effective to treat said disorder in the subject. There is no prior art of record that would anticipate or render such a claimed method obvious.

Also in the prior Office Action, the Examiner rejected claim 1 under 35 U.S.C. §112, first paragraph, on grounds that: (1) "[t]he genus now provided has no antecedent

basis in the specification as filed"; and (2) the use of the phrase "at least one" in two instances in such claim "opens the claim to further unknowns." Furthermore, the Examiner stated that 37 C.F.R. §1.145 requires that claim 1 be returned to the scope originally filed and searched, which the Examiner contends did not include any instances of heterocyclic groups.

Although applicants disagree with the Examiner's characterization of the scope of claim 1, as originally filed, by this Amendment, both references to "heterocyclic groups" have been deleted from claim 1. In addition claim 1 has been amended to use the phrase "one or more" in lieu of the phrase "at least one" as suggested by the Examiner. In view of the foregoing amendments to claim 1, reconsideration of the rejection thereof is respectfully requested.

In the prior Office Action, the Examiner rejected claims 3 and 5 as being dependent upon a rejected claim (claim 1). Applicants respectfully submit that in view of the amendments to claim 1, the prior rejection of claims 3 and 5 should now be withdrawn.

Also in the prior Office Action, the Examiner indicated that claims 10-31, 46, 47 and 51-57 were objected to as allowable, but dependent on a rejected claim (claim 1). It is respectfully submitted that in view of the amendments to claim 1, claims 10-31, 46, 47 and 51-57 are now in condition for allowance.

Finally, the Examiner indicated that claims 32-45 and 48-50, which claimed compounds including one or more heterocyclic groups, were "not properly before us." In view of the amendments to claim 1, applicants have canceled claims 32-45 and 48-

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50. Applicants reserve the right to prosecute the canceled subject matter in one or more divisional or continuation applications to be filed at a later date.

Conclusion

In view of the foregoing, the issuance of a timely Notice of Allowance is respectfully requested.

Respectfully submitted,

RANKIN, HILL, PORTER & CLARK, L.L.P.

A handwritten signature in dark ink, appearing to read "Randolph E. Digges, III", is written over a horizontal line.

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